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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,224	09/14/2000	Eugene J. Alexander	STAN-144/04US	3054
36806	7590	12/10/2004	EXAMINER	
IMAGING THERAPEUTICS, INC.			JUNG, WILLIAM C	
C/O ROBBINS & PASTERNAK			ART UNIT	
1731 EMBARCADERO ROAD			PAPER NUMBER	
SUITE 230			3737	
PALO ALTO, CA 94304-3303			DATE MAILED: 12/10/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/990,010	SUBRAMANYAN ET AL.
Examiner	Art Unit	
William Jung	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 February 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 94-108 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 94, 96 and 102-108 is/are rejected.

7)  Claim(s) 95 and 97-101 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 22.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 34-93 and 109-168 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 21.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 94, 102, 106, and 107 are rejected under 35 U.S.C. 102(b) as being anticipated by *Paul et al* (US 5,320,102).

*Paul et al* anticipate all claimed features in claims 94, 102, 106, and 17. *Paul et al* disclose MRI imaging method obtain three-dimensional image of joint and bone where the images include healthy or normal and diseased cartilage tissue and evaluating the images about geometry such as location and size of the healthy bone and/or cartilage to assess the disease (col. 3, line 57 – col. 4, line 39; col. 8, lines 11-61). Diagnosing the disease or damage state of the bone or cartilages dictates the treatment or therapy method (col. 1, lines 37-47).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Paul et al* as applied to claim 94 above, and further in view of *Robinson* (US 5,291,401).

*Paul et al* substantially disclose all claimed features in claim 96. However, *Paul et al* do not disclose transferring image data from one location to another for image processing and analysis such as teleradiology. *Robinson* teaches that the diagnostic data such as radiological images such as *Paul et al*'s MR images of bone can be transfer to remote location for processing an analysis. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply *Robinson*'s teleradiology to *Paul et al*'s medical image diagnostic method.

6. Claim 103-105 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Paul et al* as applied to claims 94, 106, and 107 above, and further in view of *Hunziker* (US 5,206,023).

*Paul et al* substantially disclose all claimed features in claims 103-105 and 108. However, *Paul et al* do not disclose specific method in which the treatment is carried out. *Hunziker* teaches that the bone diseases/damages treatment includes chondrocytes, autografting by cell adhesion promoting factor with no-human material such as chemotactic agents, artificial implantation such as composite matrix (col. 4, line 5 – col. 6, line 30). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply *Hunziker*'s treatment method to *Paul et al*'s diagnostic method of bone and/or cartilage diseases/damages to assess the method of treatment.

***Allowable Subject Matter***

7. Claims 95 and 97-101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung whose telephone number is 703-605-4364. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WCJ  
May 10, 2004

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